

Notice of Allowability

Application No.

09/904,462

Applicant(s)

ASHKENAZI ET AL.

Examiner

Dong Jiang

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment filed on 5/10/04.
2. ☒ The allowed claim(s) is/are 44-46, 50 and 51 to issue as 1-5.
3. ☒ The drawings filed on 7/13/04 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DETAILED OFFICE ACTION

Applicant's amendment filed on 10 May 2004 is acknowledged and entered. Following the amendment, claim 44 is amended.

Currently, claims 44-46, 50 and 51 are pending and under consideration.

The declaration under 37 CFR 1.132 filed 10 May 2004 is sufficient to overcome the rejection of claims 44-46, 50 and 51 based upon the prior art references by Gebe et al., WO 98/39443 (11 September 1998).

In view of the papers filed on 10 May 2004, the inventorship in this nonprovisional application has been changed by the deletion of Avi Ashkenazi, David Botstein, Dan L. Eaton, Napoleone Ferrara, Ellen Filvaroff, Sherman Fong, Wei-Qiang Gao, Hanspeter Gerber, Mary E. Gerritsen, J. Christopher Grimaldi, Ivar J. Kljavin, Jennie Mather, James Pan, Nicholas F. Paoni, Margaret Roy, Timothy A. Stewart, Daniel Tumas and P. Mickey Williams.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

Examiner's Statement for Reasons for Allowance

The following is an examiner's statement of reasons for allowance: claims 44-46, 50 and 51 of the present invention are directed to an isolated human polypeptide having SEQ ID NO:148 (347 amino acids). The specification discloses one nucleic acid (SEQ ID NO:147) and a polypeptide encoded thereby, SEQ ID NO:148, which is designated PRO229, and induces re-differentiation of chondrocytes. Said polypeptide is designated PRO229, and induces re-differentiation of chondrocytes. Prior art searches reveal that Gebe et al., WO 98/39443 (11 September 1998) discloses an amino acid sequence of a human Sp α polypeptide, which has 347 amino acid residues, and comprises amino acid residues 1-346 of SEQ ID NO:148 (347 amino acids) of the instant claims with 100% sequence identity. The only difference in sequence

Art Unit: 1646

between the two polypeptides is a single mismatch at the C-terminal end, position 347, wherein amino acid 347 of the prior art sequence is a Gly, which DNA codon is GGX; whereas amino acid 347 of the present SEQ ID NO:148 is a Val, which DNA codon is GTX. The single nucleotide at the second position of the codon is the cause of the one amino acid difference between the two polypeptides. Applicants declaration under 37 CFR 1.132, indicating that the disclosed nucleic acid sequence of SEQ ID NO:147, which encodes SEQ ID NO:148 has been confirmed and there is no sequence error found, is persuasive. As such, the polypeptide of SEQ ID NO:148 is distinct from that of Gebe's, and there is no other prior art teaches or suggests the polypeptide sequence of SEQ ID NO:148.

Conclusion:

Claims 44-46, 50 and 51 are allowed.

Advisory Information:

Any inquiry concerning this communication should be directed to Dong Jiang whose telephone number is 571-272-0872. The examiner can normally be reached on Monday - Friday from 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

A handwritten signature in black ink that reads "Lorraine Spector". The signature is written in a cursive style with a large, looping initial "L".

**LORRAINE SPECTOR
PRIMARY EXAMINER**

Dong Jiang, Ph.D.
Patent Examiner
AU1646
6/24/04